

The opinion in support of the decision is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRENT C. PARENT,
AARON J. ROTH, PATRICK O'BRIEN,
and ANDY F. SUHY, JR.

Appeal 2006-2904
Application 09/504,343¹
Technology Center 3600

Decided: September 26, 2007

Before LEE E. BARRETT, LANCE LEONARD BARRY, and
DAVID B. WALKER, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Final Rejection of claims 1-21. We have jurisdiction pursuant to 35 U.S.C. § 6(b).

We affirm-in-part.

¹ Application for patent filed February 14, 2000, entitled "System and Method for Virtual Rental Fleet," which is a continuation-in-part of Application 09/441,289, filed November 16, 1999, now U.S. Patent 7,062,446, issued June 13, 2006, and claims benefit of Provisional Application 60/166,042, filed November 17, 1999.

BACKGROUND

The invention relates to an electronic system and method for facilitating purchase, lease, and rental transactions. (Specification 4-7.)

Claim 1 is illustrative:

1. An electronic system for facilitating transactions comprising:
 - an asset configuration unit responsive to input data provided by a first user for generating a profile of an asset, said profile comprising asset specification data and a bid definition defining parameters associated with one of a purchase, rental and lease transaction of said asset;
 - a market database for storing a plurality of said asset profiles;
 - a market search module configured to search said market database based on search parameters specified by a second user and generate an identification of assets according to said search parameters, said market search module being configured to display to said second user a portion of said asset specification data for at least one of said identified assets;
 - a bid module configured to allow said second user to select said one of said identified assets for placement of a bid thereon, said bid module being further configured to provide at least one of purchase, rental and lease transaction options to said second user in accordance with said bid definition; and
 - a communications interface for facilitating electronic remote access of said system by said first and second user.

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THE REFERENCES

Berent	US 5,774,873	Jun. 30, 1998
Erickson	US 6,014,644	Jan. 11, 2000 (filed Nov. 22, 1996)
Harrington	US 6,161,099	Dec. 12, 2000 (filed May 29, 1998)

THE REJECTIONS

Claims 1-7 and 10-21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Erickson and Berent. The Examiner finds the claimed subject matter to be taught by Erickson except for the "maintenance history data" recited in claims 2, 14, and 18, which the Examiner concludes would have been obvious over the teachings of Berent.

Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Erickson, Berent, and Harrington.

DISCUSSION

Claim 1

Claim 1 does not recite "maintenance history data," as added in dependent claim 2, and therefore the rejection is based only on Erickson.

Erickson "relates to systems and methods that can be used by a plurality of buyers to request bids from a plurality of suppliers and track the responses to the request" (col. 1, lines 12-15). A vendor enters information into a database in order to allow potential buyers to identify various products

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or services offered by the vendor (col. 7, lines 45-67). A buyer wishing to purchase goods or services or request a bid from various suppliers browses the database in order to identify suppliers that offer goods or services of interest (col. 8, lines 28-32). A request for bids is broadcast to the suppliers who respond to the buyer (col. 8, lines 32-38). The buyer collects the responses and assembles the information to make a purchasing decision (col. 8, lines 39-50). The messages may use a "data cast object" which facilitates tracking and storage of responses (col. 4, line 6 to col. 5, line 21).

Erickson is an example of an online reverse auction. The buyer initiates the auction by sending out purchasing specifications that detail what the buyer wants to buy. Suppliers compete against each other to win the buyer's business. The Examiner appreciates that Erickson is a buy-side system, whereas the disclosed invention is a sell-side system, but considers the claims broad enough to read on Erickson (Answer 9-10).

It is difficult to map the claim limitations of claim 1 onto Erickson because of the different way Erickson functions. However, the breadth of claim 1 allows it to be read onto Erickson in an unintended way. Erickson has "an asset configuration unit responsive to input data provided by a first user for generating a profile of an asset, said profile comprising asset specification data" because the system allows the buyer to input data describing an asset (a profile) that the buyer wants to purchase, although as disclosed it is the seller who generates a profile of the asset. We do not agree with Appellants' argument that the first user is a supplier or seller of

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the asset (e.g., Reply Br. 5), at least so far as we have read in the claim, because the "first user" claim language is not so limited.

Arguably, Erickson teaches the profile having a "bid definition" defining parameters associated with one of a purchase, rental and lease transaction of said asset." The structure of the "bid definition" and the nature of the "parameters" are not claimed in claim 1. According to Appellants' disclosure, the bid definition is a data structure that holds parameters defining the bid date, availability date, and classes of users allowed to bid on a purchase, rental, or lease transaction (Figure 8; Specification 27-29; claims 3, 4, 6, and 7). Erickson implicitly must store a parameter related to the price to be bid by the supplier or other transaction information such as the number of units desired, the due date, etc. Only one of a purchase, rental, and lease transaction is required, so the bid for a purchase transaction in Erickson fits the limitation. As to Appellants' argument that the Examiner improperly equated purchase with trade, rent, timeshare, and leasing transactions (Br. 10-13), claim 1 only requires parameters associated with one of a purchase, rental, or lease, so regardless of the Examiner's statement, it enough that Erickson deals with a purchasing transaction. Erickson teaches "a market database for storing a plurality of said asset profiles," which can be the central database 16.

We also find that Erickson discloses "a market search module configured to search said market database based on search parameters specified by a second user and generate an identification of assets according to said search parameters, said market search module being configured to

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display to said second user a portion of said asset specification data for at least one of said identified assets." The second user is a supplier who can search the database to identify goods desired in the marketplace (col. 8, lines 1-27), although, as disclosed, it is the buyer who searches. Erickson also implicitly discloses "a bid module configured to allow said second user to select said one of said identified assets for placement of a bid thereon" because a supplier (second user) can select assets for placing a bid, where this language does not preclude the "bid" from being a bid to sell the asset, as opposed to a bid for "purchasing, renting, or leasing" the asset as later claimed. There is no dispute that Erickson teaches "a communications interface for facilitating electronic remote access of said system by said first and second user" because it is an online system.

The limitation, "said bid module being further configured to provide at least one of purchase, rental and lease transaction options to said second user in accordance with said bid definition," can be interpreted to mean that options related to one of purchase, rental, and lease transactions are provided to the second user (the seller in Erickson). Erickson discloses that the seller is provided with a sequence of prompts for information related to the bid, such as parts subtotal, labor subtotal, miscellaneous charges associated with the bid, total price, etc. (col. 13, line 61 to col. 14, line 12), which are considered to be options related to a purchase transaction.

In summary, based on our claim interpretation, we conclude that claim 1 would have been obvious over Erickson. Berent is applied for the

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limitation of "maintenance information" in claim 2 and is not applied to claim 1. Accordingly, the rejection of claim 1 is affirmed.

Claims 2-13

Claim 2 recites "wherein said asset specification data includes maintenance history data, said market search module further being configured to display said maintenance history data for said at least one of said identified assets." The Examiner states that "maintenance history data" is nonfunctional descriptive matter and, in any case, is broad enough to read on the information about vehicle ID, make, and model in Berent at column 9, lines 20-39 (Answer 7, 16-17). The Examiner concludes that it would have been obvious to combine Erickson and Berent to provide users of a trusted commerce system with maintenance history data (Answer 7-8).

Appellants argue that maintenance history data provides a different functionality and offers different advantages if it is used instead of a different kind of data and is not nonfunctional descriptive matter (Br. 14-15; Reply Br. 7). It is also argued that the list of information in Berent does not teach maintenance history data (Br. 15; Reply Br. 7-8). Appellants further argue that there is no motivation to combine (Br. 8-9).

"Nonfunctional descriptive material" is a difficult issue. On one hand, it seems that the nature of data should not be given any patentable weight unless it somehow affects the structure or method. Maintenance history data is just another kind of data that it stored with the description of the asset and does not change the structure or the method steps. Unlike the data structure

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stored in memory in *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994), which enabled more efficient data processing operations on stored data, the maintenance history data is not used by the system or method. On the other hand, the essence of business methods usually depends on the kind of data that is being used and operated on. For that reason, we conclude that "maintenance data" should be given weight in this case.

We find that the information in Berent is not specifically maintenance history data and, thus, even if Berent was combined with Erickson, it would not teach all of the limitations of claim 2. In addition, claim 2 recites "said market search module being further configured to display said maintenance history data for said at least one of said identified assets." The search module is what the seller uses in Erickson (as we are interpreting the claim) to display information from/about the buyer. Assuming, *arguendo*, that there is motivation for the buyer in Erickson to request maintenance history data in the request for bid, the search module would display a "request for maintenance history data" not "maintenance history data" itself, which does not meet the claim language. Therefore, we reverse the rejection of claim 2 and claims 3-7 and 10-13 which depend therefrom.

Harrington does not cure the deficiencies of the combination of Erickson and Berent. Therefore, the rejection of claims 8 and 9 is reversed.

Claims 14-21

Claim 14 recites "asset specification data . . . including maintenance history data" and a market search module to "display to said second user at

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least a portion of a [sic] said asset specification data including said maintenance history data." Claim 18 recites "asset specification data associated with an asset including maintenance history data" and "searching the market database . . . and displaying to the second user at least a portion of the asset specification data that includes the maintenance history data." As discussed in connection with claim 2, assuming, *arguendo*, that there is motivation for the buyer in Erickson to request maintenance history data in the request for bid, the search module or method would display a "request for maintenance history data" not "maintenance history data" itself, which does not meet the claim language. Therefore, we reverse the rejection of claims 14 and 18 and their dependent claims 15-17 and 19-21.

New ground of rejection

Claims 1, 2, 14, and 18 are rejected under 35 U.S.C. § 103(a) as unpatentable over Berent and Appellants' admitted prior art (APA) that "it is known in the passenger fleet industry to make some level of maintenance history data on particular vehicle available to the potential purchaser" (Specification, page 3, lines 19-23) and Official Notice that it was well known that automobiles can be purchased, rented, or leased.

Berent is a better reference for obviousness purposes than Erickson because it deals with an auction system like the disclosed invention, i.e., the alignment of seller and buyer with the first and second users, respectively, is the same. Although Berent does not expressly disclose "an asset configuration unit responsive to input data provided by a first user for

generating a profile of an asset, said profile comprising asset specification data," it must inherently have some mechanism to allow the first users (sellers) to provide profiles of assets of motor vehicles to be sold.

Berent does not expressly disclose "a bid definition defining parameters associated with one of a purchase, rental and lease transaction of said asset," but the system must inherently store a parameter such as price since the bid screen maintains updated information about the asking price and the current bid price (col. 9, line 35). Figure 1 of Berent discloses "a market database for storing a plurality of said asset profiles." Berent has "a market search module configured to search said market database based on search parameters specified by a second user and generate an identification of assets according to said search parameters, said market search module being configured to display to said second user a portion of said asset specification data for at least one of said identified assets" because a second user (buyer) can search for vehicles based on parameters such as location, make, model, model year (Figure 3B; col. 7, line 52 to col. 8, line 21).

Berent must also have "a bid module configured to allow said second user to select said one of said identified assets for placement of a bid thereon, said bid module being further configured to provide at least one of purchase, rental and lease transaction options to said second user in accordance with said bid definition" because the buyer can bid for purchase of the vehicles (Figure 6E; col. 9, lines 20-61). Berent also has "a communications interface for facilitating electronic remote access of said system by said first and second user" because it conducts the auction over a communications

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network. Claim 1 would have been obvious over Berent as interpreted by one of ordinary skill in the art.

The difference between Berent and the subject matter of claim 2 is that Berent does not disclose that the asset specification data includes "maintenance history data." Berent discloses an online motor vehicle auction and information system using a straightforward bidding process. Berent discloses that the "bid screen includes an image and information about the vehicle being auctioned including vehicle run number, mileage, descriptive information, vehicle ID number, and condition and grade information" (col. 9, lines 30-34). One skilled in the relevant art of online selling would have been motivated to provide maintenance history data in Berent in light of the other information taught in Berent, such as condition and grade, given the APA that it was known to provide maintenance history data to potential purchasers.

The differences between Berent and the subject matter of claims 14 and 18 are that Berent does not disclose that: (1) the asset specification data includes "maintenance history data"; and (2) the transaction is a rental transaction. It would have been obvious to provide maintenance history data in Berent given the teaching of the APA as discussed in connection with claim 1. We take Official Notice of the well-known fact that vehicles may be purchased, rented, or leased. It would have been evident to one of ordinary skill in the art to modify the system of Berent to rent vehicles, instead of sell vehicles, since renting was a known alternative to purchasing.

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We leave it to the Examiner to consider the patentability of the remaining dependent claims.

CONCLUSION

The rejection of claim 1 is affirmed.

The rejections of claims 2-21 are reversed.

A new ground of rejection is entered as to claims 1, 2, 14, and 18.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

Regarding any affirmed rejection, 37 C.F.R. § 41.52(a)(1) provides:

(a)(1) Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. . . .

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the Appellants elect to prosecute further before the Primary Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right

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to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

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